UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

THE SHADE STORE LLC, **Plaintiff,** **v.** **MADE BLINDS, LLC,** **Defendant.**	**Civil Action No.** **ECF CASE**

Plaintiff The Shade Store LLC by and through its undersigned attorneys, for its Complaint against defendant Made Blinds, LLC, alleges as follows:

INTRODUCTION

1. Plaintiff The Shade Store LLC ("TSS") operates a brick and mortar and online retail business selling solely its own eponymous window coverings, such as drapery, blinds and shades, to the public and the trade. TSS, which has showrooms across the country, also offers installation services.

2. TSS began using the trademark CUSTOM MADE SIMPLE in connection with its business in 2007 and began using the trademark MEASURING MADE SIMPLE in connection with its business in 2009. In 2016 TSS began using the trademark MOTORIZATION MADE SIMPLE, and it has sought to register MOTORIZATION MADE SIMPLE and MADE SIMPLE as trademarks with the U.S. Patent and Trademark Office.

3. Defendant Made Blinds, LLC ("MBL" or "Defendant") operates an online business under the MADE BLINDS name through which it offers and sells window coverings. Defendant sent a cease and desist letter to TSS's counsel dated April 4, 2017 asserting that TSS' use of MADE SIMPLE infringed Defendant's alleged rights in its MADE BLINDS trademark, which Defendant did not start using until November 2015. A copy of the April 4 letter is attached as Exhibit A. Notwithstanding TSS' prior rights, the April 4 letter, among other things, demands that TSS stop using **any** mark that contains the word "made".

NATURE OF ACTION

4. This is an action for declaratory judgment which arises under the Lanham Act, 15 U.S.C. § 1051, *et seq.* By this action, Plaintiff seeks a declaration that it has not infringed upon the asserted trademark rights of Defendant in its alleged marks MADE BLINDS and MADEBLINDS.COM by virtue of TSS' use and/or intended use of the marks CUSTOM MADE SIMPLE, MEASURMENT MADE SIMPLE, MOTORIZATION MADE SIMPLE and/or MADE SIMPLE (the "MADE SIMPLE marks").

JURISDICTION AND VENUE

5. This Court has jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338 with respect to the claims arising under the Lanham Act, 15 U.S.C. § 1051, *et seq.* and pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*

6. Venue is proper in this district pursuant to 28 U.S.C. § 1391 because this

is an action brought pursuant to the Lanham Act and (a) a substantial part of the events giving rise to Defendant's claims occurred within this district and (b) TSS' rights are seriously affected in this District.

THE PARTIES

7. TSS is a Delaware limited liability company with a principal place of business at 21 Abendroth Avenue, Port Chester, New York.

8. TSS operates a number of showrooms throughout this district, including showrooms at the following locations: SoHo (198 Spring Street); Midtown (225 East 59th Street); the Upper East Side (1100 Madison Avenue); and the Upper West Side (313 Columbus Avenue).

9. TSS operates the website at www.theshadestore.com through which it offers window coverings and related goods and services to the public.

10. Upon information and belief, defendant Made Blinds, LLC is a California limited liability company with a principal place of business at 1927 North Glassell Street, Orange, California.

11. Upon information and belief, Defendant operates a website at www.madeblinds.com which sells window coverings. Upon information and belief, Defendant, through its website, sells and has sold window coverings to consumers in this district.

12. Personal jurisdiction over Defendant exists because, upon information and belief, Defendant (i) transacts business within this State and judicial district through its www.madeblinds.com website and otherwise; (ii) regularly does or solicits business

within this State and judicial district; and (iii) derives substantial revenue from intrastate and interstate commerce.

FACTUAL BACKGROUND

TSS' Business

13. TSS is a family-run company. It is based on three generations of experience in custom window treatments, and has a rich heritage in luxury textiles and interior design.

14. In 1946, Milton Goldstein and his brother Jack opened a small fabric shop in Mt. Vernon, New York called Westchester Fabrics. The concept was simple: to offer customers great quality, style and value. TSS' heritage of style, quality and value can be traced back to that single fabric shop in Mt. Vernon. Westchester Fabrics provided the community with exceptional fabrics and world-class customer service. Dressmakers, designers and hobbyists came from all over to browse, shop and chat.

15. Westchester Fabrics later evolved into Home Works, a custom window treatment storefront in Westchester, New York and, in 2005, the four grandsons of Milton Goldstein in turn founded The Shade Store.

16. Since 2005 TSS has opened numerous showrooms across the United States, including several locations in this district as well as locations in Scottsdale (opened August 2014) and Los Angeles (opened May 2011).

17. TSS began operating its website at www.theshadestore.com in 2005.

18. TSS has established partnerships with some of the most respected names in the textile industry and offers its customers exclusive designs from well-known

designers such as Ralph Lauren, Diane Von Furstenberg, Kate Spade, Sunbrella, Jonathan Adler, Jeffrey Allen Marks DwellStudio, Chilewich, Echo and Novogratz.

19. Prices for TSS' custom made window coverings can start at about fifty dollars and go up from there to five thousand dollars for a complete installation for one window; multiple windows can cost even more.

20. When a customer places an order with TSS, the order is shipped in packaging bearing the THE SHADE STORE name and logo.

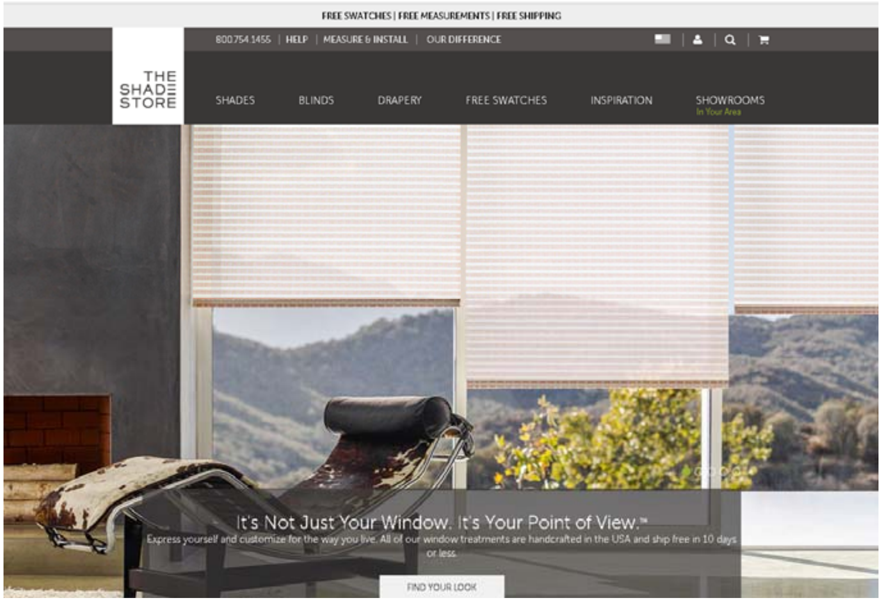
21. As shown in the promotional material reproduced below, a central aspect of TSS' marketing has been its ability to simplify, for consumers, the process of measuring, ordering and installing window coverings customized to fit their windows. Excerpts from the marketing material are reproduced in Exhibit B.

WE'LL MAKE IT SIMPLE
START IN ONE OF OUR SHOWROOMS.
That's where you can see our very latest fabrics and finishes, all in one place.
GET ADVICE FROM OUR DESIGN CONSULTANTS.
Highly trained and experienced design professionals are available in every showroom, over the phone, via email or live chat — whatever method works best for you.
ORDER FREE SWATCHES.
We want you to see and feel our gorgeous materials, so we send our swatches free and fast — they arrive in 1-3 days.
SHOP 24/7.
Visit THESHADESTORE.COM to browse our full collection, order free swatches or just get inspired!
MEASURE AND INSTALL.
Let us handle the measuring and installation. We have a nationwide team of experts who can assist every step of the way.
Every installation done through our network is backed by our 100% satisfaction guarantee and delivered with white-glove concierge service.

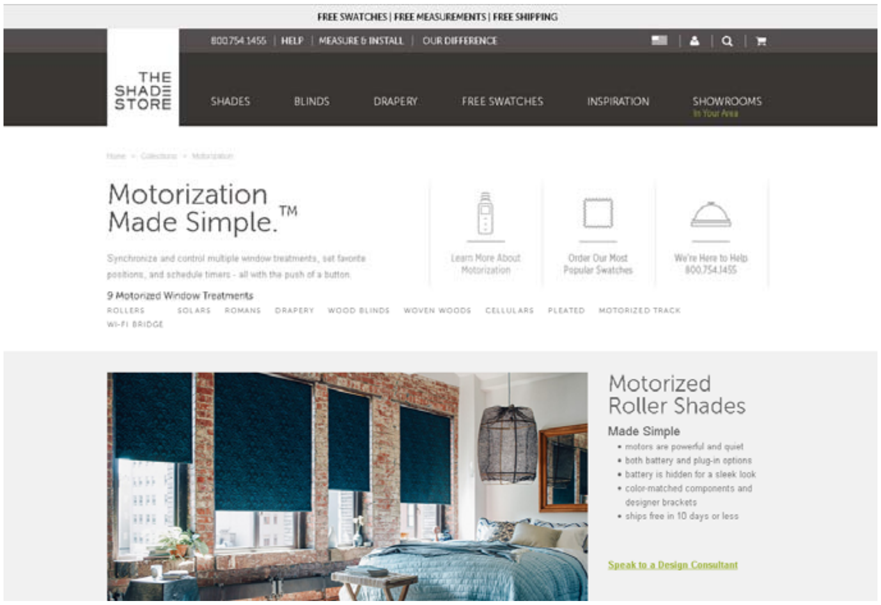
22. To convey that concept to customers and potential customers, TSS adopted the CUSTOM MADE SIMPLE trademark in 2007 and the MEASURING MADE SIMPLE trademark in 2009.

23. As motorized window coverings became an industry trend, TSS adopted the MOTORIZATION MADE SIMPLE trademark in 2016. TSS subsequently adopted MADE SIMPLE as a trademark because of its longstanding use of that phrase in other marks and because it succinctly summarized TSS' philosophy: everything consumers want for window coverings, MADE SIMPLE.

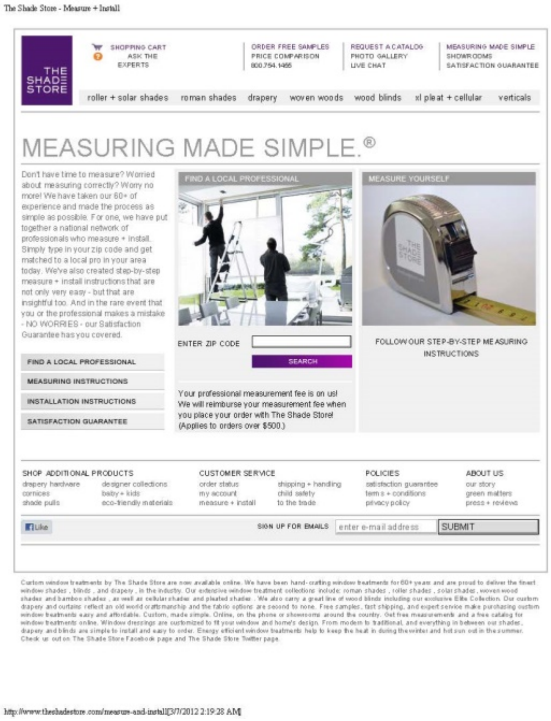
24. TSS has adopted a uniform look across its website, stores and marketing materials. Shown below is an image of the current home page of TSS' website. Excerpts from TSS' current website are attached as Exhibit C.


FREE SWATCHES | FREE MEASUREMENTS | FREE SHIPPING
800.754.1455 | HELP | MEASURE & INSTALL | OUR DIFFERENCE
THE SHADE STORE
SHADES
BLINDS
DRAPERY
FREE SWATCHES
INSPIRATION
SHOWROOMS
In Your Area
It's Not Just Your Window. It's Your Point of View.™
Express yourself and customize for the way you live. All of our window treatments are handcrafted in the USA and ship free in 10 days or less.
FIND YOUR LOOK

25. Another image from the current version of TSS' website appears below:


FREE SWATCHES | FREE MEASUREMENTS | FREE SHIPPING
800.754.1455 | HELP | MEASURE & INSTALL | OUR DIFFERENCE
THE SHADE STORE
SHADES
BLINDS
DRAPERY
FREE SWATCHES
INSPIRATION
SHOWROOMS
Motorization Made Simple.™
Synchronize and control multiple window treatments, set favorite positions, and schedule timers - all with the push of a button
9 Motorized Window Treatments
ROLLERS
SOLARS
ROMANS
DRAPERY
WOOD BLINDS
WOVEN WOODS
CELLULARS
PLEATED
MOTORIZED TRACK
WI-FI BRIDGE
Learn More About Motorization
Order Our Most Popular Swatches
We're Here to Help 800.754.1455
Motorized Roller Shades
Made Simple
motors are powerful and quiet
both battery and plug-in options
battery is hidden for a sleek look
color-matched components and designer brackets
ships free in 10 days or less
Speak to a Design Consultant

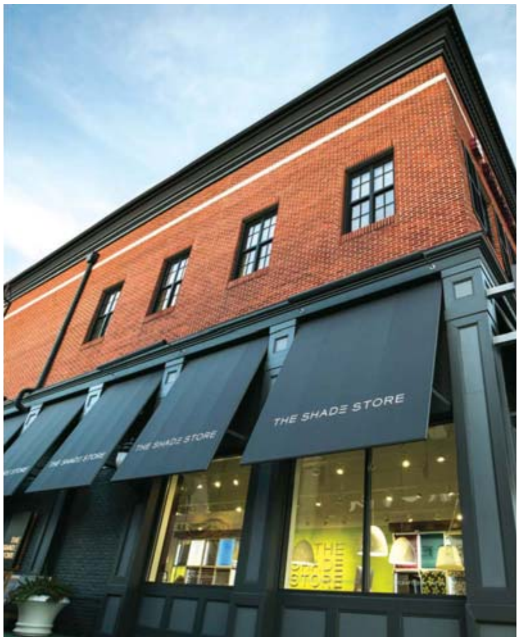
26. An image from the 2012 version of TSS' website appears below. A copy of this image is attached as Exhibit D.


The Shade Store - Measure + Install
THE SHADE STORE
SHOPPING CART
ASK THE EXPERTS
ORDER FREE SAMPLES
PRICE COMPARISON
800.754.1455
REQUEST A CATALOG
PHOTO GALLERY
LIVE CHAT
MEASURING MADE SIMPLE
SHOWROOMS
SATISFACTION GUARANTEE
roller + solar shades
roman shades
drapery
woven woods
wood blinds
xl pleat + cellular
verticals
MEASURING MADE SIMPLE.®
Don't have time to measure? Worried about measuring correctly? Worry no more! We have taken our 60+ of experience and made the process as simple as possible. For one, we have put together a national network of professionals who measure + install. Simply type in your zip code and get matched to a local pro in your area today. We've also created step-by-step measure + install instructions that are not only very easy - but that are insightful too. And in the rare event that you or the professional makes a mistake - NO WORRIES - our Satisfaction Guarantee has you covered.
FIND A LOCAL PROFESSIONAL
MEASURING INSTRUCTIONS
INSTALLATION INSTRUCTIONS
SATISFACTION GUARANTEE
FIND A LOCAL PROFESSIONAL
ENTER ZIP CODE
SEARCH
Your professional measurement fee is on us! We will reimburse your measurement fee when you place your order with The Shade Store! (Applies to orders over $500.)
MEASURE YOURSELF
FOLLOW OUR STEP-BY-STEP MEASURING INSTRUCTIONS
SHOP ADDITIONAL PRODUCTS
drapery hardware
cornices
shade pulls
designer collections
baby + kids
eco-friendly materials
CUSTOMER SERVICE
order status
my account
measure + install
shipping + handling
child safety
to the trade
POLICIES
satisfaction guarantee
terms + conditions
privacy policy
ABOUT US
our story
green matters
press + reviews
Like
SIGN UP FOR EMAILS
enter e-mail address
SUBMIT
http://www.theshadestore.com/measure-and-install[3/7/2012 2:19:28 AM]

27. An image of the exterior of one of TSS' showrooms appears below.

THE SHADE STORE

28. An image of the exterior of another TSS showroom appears below.



29. The cover of TSS' 2011 catalog appears below. The cover prominently features the CUSTOM MADE SIMPLE mark. Excerpts from the 2011 catalog are attached as Exhibit E.

THE SHADE STORE
custom made simple.

custom made simple.

30. Reproduced below is the cover of TSS' 2013 catalog. The CUSTOM MADE SIMPLE mark appears below the THE SHADE STORE mark. Excerpts from the 2013 catalog are attached as Exhibit F.

THE SHADE STORE

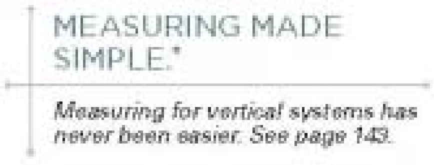
THE SHADE STORE
custom made simple.

31. Additional pages from the 2013 catalog appear below. The page on the right features the MEASURING MADE SIMPLE mark, and the page on the left features MADE SIMPLE.

MEASURE + INSTALL
MADE SIMPLE.

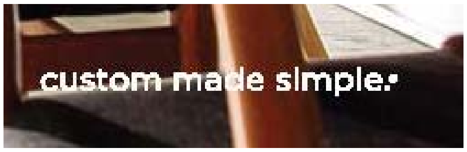
MEASURING MADE
SIMPLE.*

MEASURE + INSTALL
MADE SIMPLE.
Measuring and installing custom window treatments has never been easier. Step-by-step instructions are available online or type in your zip code to get matched with a local professional.
theshadestore.com/measure


MEASURING MADE
SIMPLE.*
Measuring for vertical systems has never been easier. See page 143.

32. An image of the cover of TSS' 2017 catalog is reproduced below. The CUSTOM MADE SIMPLE mark appears on the cover. Excerpts from the 2017 catalog are attached as Exhibit G.

THE
SHADE
STORE



33. Below is an image showing the cover of TSS' 2016 catalog. The CUSTOM MADE SIMPLE mark appears here, as well. Excerpts from the 2016 catalog are attached as Exhibit H.

THE
SHADE
STORE
custom made simple.

custom made simple.

34. TSS' MADE SIMPLE marks also appear on other materials, such as promotional e-mails sent to customers and print and online ads. They also appear in TSS' showrooms and in other ways customarily used in the trade.

35. TSS' MADE SIMPLE marks are all used or will be used in connection with the look TSS has adopted for itself and with the THE SHADE STORE mark and logo.

TSS' Trademark Rights

36. TSS owns incontestable U.S. trademark Registration No. 3,313,329 for the mark CUSTOM MADE SIMPLE for use in connection with on-line retail store services, featuring window blinds, curtains and decorative window treatments. The registration issued on October 16, 2007 and claims a date of first us of May 10, 2007. By virtue of its registration, TSS' rights date back to November 22, 2006. A copy of this registration is attached as Exhibit I.

37. TSS also owns U.S. trademark Registration No. 4,741,513 for the mark CUSTOM MADE SIMPLE for a wide variety of goods and services. The registration issued on May 26, 2015 and claims a date of first use of May 10, 2007. A copy of this registration is attached as Exhibit J.

38. TSS also owns U.S. trademark Registration No. 4,415,482 for the mark MEASURING MADE SIMPLE for use in connection with retail and online store services in the field of window shades, draperies and related accessories and hardware. The registration issued on October 8, 2013 and claims a date of first use of January 1, 2009. A copy of this registration is attached as Exhibit K.

39. TSS also owns pending U.S. application serial no. 87/288,968 for the mark MOTORIZATION MADE SIMPLE, covering a wide range of goods and services related to window coverings. The application was filed based on both use and an intent-to-use. To the extent that the mark is in use, it has been in use since at least as

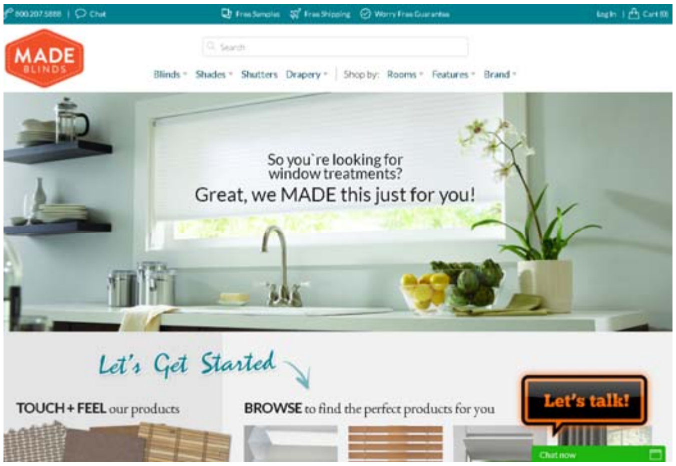
early as November 2016. Attached as Exhibit L is a printout from the U.S. Trademark Office's website showing the status of this application.

40. TSS also owns pending U.S. application serial no. 87/288,796 for the mark MADE SIMPLE for use in connection with a diverse array of goods and services. The application was filed on January 7, 2017 based on an intent-to-use. Attached as Exhibit M is a printout from the U.S. Trademark Office's website showing the status of this application.

41. TSS also owns pending U.S. application serial no. 86/717,784 for another mark featuring the term "made", GUILTY PLEASURES MADE POSSIBLE BY THE SHADE STORE for use in connection with a diverse array of goods and services. The application was filed on August 7, 2015 based on an intent-to-use. Attached as Exhibit N is a printout from the U.S. Trademark Office's website showing the status of this application.

Defendant's Business

42. Defendant operates an online business at www.madeblinds.com through which it sells window coverings to consumers. An image of Defendant's website from April 7, 2017 appears below. A printout from Defendant's website is attached as Exhibit O.


MADE
BLINDS
Blinds Shades Shutters Drapery Shop by: Rooms Features Brand
So you're looking for window treatments?
Great, we MADE this just for you!
Let's Get Started
TOUCH + FEEL our products
BROWSE to find the perfect products for you
Let's talk!

43. Defendant's website is replete with uses of its mark. This is apparently the primary form in which Defendant uses its mark.

44. The cost of Defendant's products generally ranges from around thirty dollars to a maximum of around two hundred dollars—less than the cost of TSS' products which, as noted, run from $50 to $5,000 for a single window.

45. Defendant's target market is consumers who prefer to do things themselves and install products on their own. If Defendant's customers are looking for someone to install their window coverings, Defendant refers them to another company.

46. Upon information and belief, after receiving an order, Defendant does not itself ship products to customers. Instead, Defendant refers the order to third party vendors who then ship products to customers in packaging that bears the name of the third party vendor and does not bear Defendant's name or trademarks.

Defendant's Trademark Registrations

47. Defendant has secured U.S. trademark Registration No. 4,933,638 for

MADE BLINDS for use in connection with electronic commerce services, namely, providing information about window covering products via telecommunication networks for advertising and sale purposes; distributorship services in the field of window coverings. The registration, which issued on April 5, 2016 and claims a date of first use of November 2015, is based on an application that was filed in December 2014.

48. Defendant has secured U.S. trademark Registration No. 4,933,639 for MADEBLINDS.COM for use in connection with electronic commerce services, namely, providing information about window covering products via telecommunication networks for advertising and sale purposes; distributorship services in the field of window coverings. The registration, which issued on April 5, 2016 and claims a date of first use of November 2015, is based on an application that was filed in December 2014.

49. Upon information and belief, Defendant began using its mark **eight years after** TSS began using its CUSTOM MADE SIMPLE mark and secured a registration for that mark.

50. Upon information and belief, Defendant began using its mark **six years after** TSS began using its MEASURING MADE SIMPLE mark and **four years after** TSS secured a registration for that mark.

51. Defendants are not the only party to use or intend to use the term "made" in connection with blinds, shades, draperies or related goods or services. A listing of

numerous such third party trademark registrations and applications is attached as Exhibit P.

52. No instances of confusion between TSS' CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE and MADE SIMPLE marks and Defendant's mark have been reported, and Defendant has not identified any instances of confusion.

Defendant's April 4, 2017 Letter

53. On April 4, 2017 Defendant sent a "cease and desist" letter to TSS' counsel.

54. Despite TSS' well known prior rights in CUSTOM MADE SIMPLE and MEASURING MADE SIMPLE, the April 4 "cease and desist" letter refers to TSS' "**illegal** use of MADE SIMPLE" (emphasis added).

55. The April 4 letter further states that "SS's use of the **Infringing** Mark **infringes MB's rights** in the Trademarks." (emphasis added). The basis for this allegation is that the marks of both parties feature the term "MADE".

56. Additionally, the April 4 letter states

> **SS's liability for trademark infringement is significant**. As you are undoubtedly aware, MB is entitled to SS's profits that resulted from the **infringement** as well as MB's damages pursuant to 15 U.S.C. § 1117. Further, we consider any use of confusingly similar trademarks by SS to be **willful infringement**, and MB would seek treble damages, attorney's fees and costs as permitted by the Lanham Act (emphasis added).

These statements are made notwithstanding the fact that TSS' known rights in

CUSTOM MADE SIMPLE and MEASURING MADE SIMPLE predate Defendant's alleged rights.

57. The April 4 letter includes the following demands:

> 1) abandon the U.S. Trademark Application for the Infringing Mark, 2) agree to **cease all use** of the Infringing Mark and **any other mark that contains the word "made" or a confusingly similar term**, 3) provide an accounting of all of SS's sales of window treatments under the Infringing Mark **so that MB can assess an appropriate damages award**, and 4) **agree not to use the Infringing Mark or any other similar mark** in connection with window treatments, window coverings, blinds, or related goods or services (emphasis added).

58. Finally, the April 4 letter concludes with an implicit threat of legal action: "Please contact me no later than April 17, 2017 to confirm SS's intent to comply with MB's reasonable demands. If we do not hear from you, we will assume that SS is not interested in an amiable resolution and we will advise MB accordingly."

59. Contrary to Defendant's conclusions, no marketplace confusion has arisen between Defendant's MADE BLINDS and MADEBLINDS.COM marks and TSS' MADE SIMPLE marks.

60. Defendant has not notified TSS of any marketplace confusion.

61. On information and belief, Defendant has no knowledge of any marketplace confusion.

62. Based on Plaintiff's current use and/or intended use of CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE and MADE SIMPLE, Defendant's demand that TSS stop using any mark that contains the word "made" or a confusingly similar term, and Defendant's implied threat of litigation, TSS has an objective apprehension of litigation initiated by Defendant.

63. By virtue of the foregoing, there is an actual, present and justiciable controversy between Plaintiff and Defendant, and Plaintiff is compelled to seek a declaration from this Court that its use and/or intended use of the MADE SIMPLE marks and/or any other mark which contains the term “made” do not infringe Defendant’s alleged , MADE BLINDS and MADEBLINDS.COM marks.

COUNT I
DECLARATION UNDER 28 U.S.C. §2201 OF
NON-INFRINGEMENT OF TRADEMARK UNDER THE LANHAM ACT

64. Plaintiff repeats and realleges each allegation contained in paragraphs 1 through 63 as if set forth in full herein.

65. The April 4, 2017 cease and desist letter objecting, among other things, to TSS’ use of the term “made” creates an actual, present and justiciable controversy between the parties.

66. TSS has been using its CUSTOM MADE SIMPLE and MEASURING MADE SIMPLE marks since long before Defendant adopted and registered its , MADE BLINDS and MADEBLINDS.COM marks.

67. TSS, by its use and/or intended use of the MADE SIMPLE marks and/or any other mark including the term “made” has not infringed and is not infringing, directly or indirectly, contributorily, by inducement or otherwise, any mark owned by Defendant, including any trademark rights that it owns in any valid MADE BLINDS mark.

68. Accordingly, TSS requires a judicial determination of rights and duties of the parties under 15 U.S.C. §§1114 and 1125(a) and a declaratory judgment that TSS' use and/or intended use of the marks CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE and/or MADE SIMPLE does not infringe, directly or contributorily, any valid , MADE BLINDS and MADEBLINDS.COM marks held by Defendant.

COUNT II
DECLARATION UNDER 28 U.S.C. §2201 OF
NO UNFAIR COMPETITION UNDER THE COMMON LAW OF THE STATE OF NEW YORK

69. Plaintiff repeats and realleges each allegation contained in paragraphs 1 through 68 as if set forth in full herein.

70. The April 4, 2017 cease and desist letter objecting, among other things, to TSS' use of the term "made" creates an actual, present and justiciable controversy between the parties.

71. TSS has been using its CUSTOM MADE SIMPLE and MEASURING MADE SIMPLE marks since long before Defendant adopted and registered its , MADE BLINDS and MADEBLINDS.COM marks.

72. TSS, by its use and/or intended use of the MADE SIMPLE marks and/or any other mark including the term "made" has not infringed and is not infringing, directly

or indirectly, contributorily, by inducement or otherwise, any mark owned by Defendant, including any trademark rights that it owns in any valid MADE BLINDS mark.

73. Accordingly, TSS requires a judicial determination of rights and duties of the parties under the common law of the State of New York and a declaratory judgment that TSS' use and/or intended use of CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE and/or MADE SIMPLE has not resulted in any act of unfair competition.

WHEREFORE, Plaintiff demands judgment:

A. That the Court issue a declaration that TSS' use of CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE, MADE SIMPLE and GUILTY PLEASURES MADE POSSIBLE BY THE SHADE STORE does not infringe, directly or contributorily, any valid mark held by Defendant under 15 U.S.C. §§1114 and 1125(a), the laws of the state of New York, or the common law;

B. That the Court declare that Plaintiff is not violating any rights of Defendant with respect to any trademark at issue;

C. That the Court declare that Plaintiff has not engaged in any act of unfair competition;

D. That Defendant and any affiliated entities, subsidiaries or parent companies be barred from instituting any actions before the Trademark Trial and Appeal Board that would restrict or prohibit Plaintiffs' right to use and register CUSTOM MADE SIMPLE, MEASURING MADE SIMPLE, MOTORIZATION MADE SIMPLE, MADE SIMPLE and/or GUILTY PLEASURES MADE POSSIBLE BY THE SHADE STORE;

E. That the Court award Plaintiff its reasonable attorneys' fees pursuant to 15 U.S.C. §1117 (A);

F. That Plaintiff be awarded its costs to the extent permitted by law; and

G. That Plaintiff be awarded such other and further relief as the Court may deem just and proper.

JURY DEMAND

Plaintiff demands a trial by jury.

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Dated: April 14, 2017
New York, New York